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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,707	02/09/2004	Matthew Mills	04-13161	9540

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EXAMINER	
ROANE, AARON F	

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,707	MILLS, MATTHEW	
	Examiner	Art Unit	
	Aaron Roane	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-22* is/are pending in the application.

4a) Of the above claim(s) *7,8,10,11,20 and 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,12-19 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 7-11, 20 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/15/2005.

The examiner will now address Applicant's traversal. First, on page 1, the 1st line of the last paragraph, Applicant asserts "that the restriction requirement is improper and should be withdrawn." The examiner strongly disagrees and submits that the restriction requirement is proper since the present application contains inventions that are related but distinct (see MPEP 806.05, 806.05(e)).

Next, Applicant asserts that 'the examiner has failed to show that there would be a "serious burden" if all the figures (claims) were examined together.' It is not required that the examiner shows a serious burden, but only that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." In the examiner's opinion, searching and examining all of the claims does present a serious burden and this in connection with satisfying the criteria for a proper restriction requirement under distinctness is why the requirement has been made and maintained.

Applicant's comments regarding the present restriction requirement and In re Lee, 199 U.S.P.Q. (BNA) 108 (Comm'r Pat. & Trademarks 1978) are noted and valid. It should be pointed out if Applicant submitted another application presenting (claiming) the withdrawn claims, it would be improper to reject these claims under double patenting. However, the examiner can say that if, such an application is submitted, great care will be taken in order to avoid such an obvious error.

Finally, the restriction requirement is maintained and reaffirmed. The examiner will examine claims 1-6, 12-19 and 22.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 12, 13, 15-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Segers (USPN 6,383,053 B1).

Regarding claims 1, 2, 5 and 6, Segers discloses a thermal device for applying thermal energy to the body of a person, animal or other surface, comprising: degermed grain (25);

and a generally rectangular enclosure (62) made of fabric and configured to enclose said degermed grain, see col. 1-6 and figures 1-5B.

Regarding claims 3 and 4, Segers discloses the claimed invention. The recitation of "oven dried" and/or "kiln dried" is interpreted as a method of manufacture or product-by-process recitation. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Regarding claims 12, 13, 17 and 19, Segers discloses a thermal device for applying thermal energy to the body of a person, animal or other surface, comprising: dissected, segmented organic filler in the form of a degermed grain (25); and a generally rectangular enclosure or receptacle (62) is configured to enclose said segmented organic filler, see col. 1-6 and figures 1-5B.

Regarding claims 15 and 16, Segers discloses the claimed invention. The recitation of "oven dried" and/or "kiln dried" is interpreted as a method of manufacture or product-by-process recitation. The determination of patentability in a product-by-process claim is

based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segers (USPN 6,383,053 B1) in view of Adamec (USPN 5,948,010).

Regarding claim 14, Segers discloses the claimed invention except for using an embryo-free segmented organic filler. Adamec discloses a thermal pad/wrap and teach the use of alternate thermal fillers including rice, corn, peas, dried beans and even sand in order to serve as thermal agents. White rice is brown rice that has had the husk, bran and germ

removed and therefore white rice is embryo-free. However, the rice recited by Adamec is either brown rice or white rice, see col. 1-4. Where there is a limited universe of potential options, the selection of any particular option would have been obvious to one of ordinary skill in the art. In re Jones, 412 F.2d 241, 162 USPQ 224 (CCPA 1969). Therefore, at the time of the invention, it would have been an obvious matter of design choice to one of ordinary skill in the art to use white rice as a thermal agent/filler, as taught by Adamec, as an alternative to the cherry pits of Segers.

Regarding claims 18 and 22, Segers discloses the claimed invention except for using corn as the thermal filler. Adamec discloses a thermal pad/wrap and teach the use of alternate thermal fillers including rice, corn, peas, dried beans and even sand in order to serve as thermal agents, see col. 1-4. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Segers, as taught by Adamec, to use corn as alternative thermal filler.

Response to Arguments

Applicant's arguments with respect to claims 1-21 (note claim 9 has been cancelled while claims 7, 8, 10, 11, 20 and 21 have been withdrawn), filed 3/10/2005, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. A.R.
September 13, 2005

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER